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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/840,110

05/05/2004

Martin Weel

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08/19/2009

WITHROW & TERRANOVA CT  
100 REGENCY FOREST DRIVE , SUITE 160  
CARY, NC 27518

EXAMINER

DUONG, OANH L

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/840,110	<b>Applicant(s)</b> WEEL, MARTIN	
	<b>Examiner</b> OANH DUONG	<b>Art Unit</b> 2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 61-64,66-70 and 72-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-64,66-70 and 72-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/22/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 61-64, 66-70, and 72-92 are presented for examination.

Claims 1-60, 65, 71, and 93-108 have been canceled.

### ***Claim Rejections – 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The amended claim 61 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The amended claim 61 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The Applicant’s method of claim 61 including steps of comparing, selecting, and delivering are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

Thus, claim 61 is non-statutory since it is not requisitely tied to another statutory

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class and it does not requisitely transform underlying subject matter to different state or thing.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 61-64, 66-70, 75, 77-81, 85, 87-90, and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chislenko et al. ("Chislenko"), US 6,041,311, in view of Chang, Us 2002/0168938 A1..

Regarding claim 61, Chislenko teaches a method comprising:

comparing each of a plurality of user profiles with a target user profile of a first user associated with a media player device (*i.e.*, "*comparing that user's profile with the profile of every other user of the system*", col. 5 lines 51-55);

selecting a matching user profile from the plurality of user profiles (read as finding at least one other person with similar tastes) (*i.e.*, "*similarity factors are used to select a plurality of users that have a high degree of correlation to a user*", col. 8 lines 1-2);

selecting of a playlist (*i.e.*, "The neighboring users are selected based on the similarity factors (step 106). The neighboring users are weighted, and recommendations for items are arrived", col. 11 lines 9-34); and

delivering a playlist to the media player device (i.e., to recommend/deliver (music) items/playlist to a user, col. 19 lines 41-42).

Chislenko does not explicitly teach a playlist of a matching user associated with the matching user profile.

Chang teaches system and method wherein coordinated and synchronized music playback among peer listeners is achieved. Chang teaches communicate a playlist of a matching user associated with the matching user profile (i.e., *"the local apparatus sends its own profile, which can be a list of song, to the remote party", page 2 paragraphs [0021] and [0024]*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement Chislenko's playlist as a playlist of a matching user associated with the matching user profile as taught by Chang. One would be motivated to do so to synchronize song playback between two or more users who wish to share mutual music listening (Chang, page 1 paragraph [0007]).

Regarding claim 78, Chislenko teaches a media player device comprising:  
a communication interface communicatively coupling the media player device to a network (col. Fig. 4); and

a control system associated with the communication interface and adapted to:

compare each of a plurality of user profiles with a target user profile of a first user associated with a media player device (i.e., *"comparing that user's profile with the profile of every other user of the system", col. 5 lines 51-55*);

selecting a matching user profile from the plurality of user profiles (read as finding at least one other person with similar tastes) (i.e., *"similarity factors are used to select a plurality of users that have a high degree of correlation to a user"*, col. 8 lines 1-2); and

request a playlist from a server storing the playlist to the media player device (i.e., to request recommendations, col. 20 lines 40-67).

Chislenko does not explicitly teach a playlist of a matching user associated with the matching user profile; and play at a least a portion of a song identified on the playlist.

Chang teaches system and method wherein coordinated and synchronized music playback among peer listeners is achieved. Chang teaches delivery of a playlist of a matching user associated with the matching user profile to the media player device (i.e., *the local apparatus sends its own profile, which can be a list of songs, to the remote party, page 2 paragraphs [0021] and [0024]*); and play at a least a portion of a song identified on the playlist (i.e., *play the selected song, page 2 paragraph [0024]*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement Chislenko's playlist as a playlist of a matching user associated with the matching user profile; and play at a least a portion of a song identified on the playlist as taught by Chang. One would be motivated to do so to synchronize song playback between two or more users who wish to share mutual music listening (Chang, page 1 paragraph [0007]).

Regarding claim 89, Chislenko teaches a server comprising:

a communication interface communicatively coupling the media player device to a network (col. Fig. 4); and

a control system associated with the communication interface and adapted to:

store a plurality of playlists each associated with one of a plurality of users (i.e., *item profiles are stored, col. 19 lines 8-15*)

compare each of a plurality of user profiles with a target user profile of a first user associated with a media player device (i.e., *"comparing that user's profile with the profile of every other user of the system", col. 5 lines 51-55*);

selecting a matching user profile from the plurality of user profiles (read as finding at least one other person with similar tastes) (i.e., *"similarity factors are used to select a plurality of users that have a high degree of correlation to a user", col. 8 lines 1-2*), the matching user profile associated with a second user from a plurality of users (i.e., col. 5 lines 54-55);

effect selection of a playlist from the plurality of playlists for delivery to the media player device (i.e., *"The neighboring users are selected based on the similarity factors (step 106). The neighboring users are weighted, and recommendations for items are arrived", col. 11 lines 9-34*); and

communicate the playlist to the media device (i.e., to recommend/deliver (music) items/playlist to a user, col. 19 lines 41-42).

Chislenko does not explicitly teach playlist of the second user.

Chang teaches system and method wherein coordinated and synchronized music playback among peer listeners is achieved. Chang teaches communicate playlist

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of second user to the media device (*i.e., the local apparatus sends its own profile, which can be a list of song, to the remote party*", page 2 paragraphs [0021] and [0024]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement Chislenko's playlist as playlist of second user as taught by Chang. One would be motivated to do so to synchronize song playback between two or more users who wish to share mutual music listening (Chang, page 1 paragraph [0007]).

Regarding claims 62, 79, and 90, Chislenko teaches the method of claim 61 wherein the matching user profile is one of the plurality of user profiles most similar to the target user profile (*i.e., col. 11 lines 9-24*).

Regarding claims 63 and 88, Chislenko teaches the method of claim 61 wherein a plurality of playlists including the playlist are stored by at least one server, each of the plurality of playlists is a playlist of one of a plurality of users including the matching user, and each of the plurality of users is associated with one of the plurality of user profiles (*i.e., col. 11 lines 25-29*).

Regarding claim 64, Chislenko teaches the method of claim 63 wherein the step of comparing is performed by the at least one server storing the plurality of playlists (col. 19 line 40-col. 20 line 29).



Regarding claim 66, Chislenko-Chang teaches the method of claim 63 wherein the step of comparing is performed by the media player device (i.e., Chang, page 2 paragraph [0021]).

Regarding claim 67, Chislenko teaches the method of claim 66 further comprising requesting delivery of the playlist from the at least one server to the media player device (col. 21 lines 1-5).

Regarding claims 68 and 80, Chislenko teaches the method of claim 63 wherein the at least one server comprises central server (Fig. 4, col. 20 lines 28-29).

Regarding claims 69 and 81, Chislenko-Chang teaches the method of claim 63 wherein the at least one server comprises a plurality of peer media player devices forming a Peer-to-Peer (P2P) network (i.e., Chang, page 1 paragraph [0008]).

Regarding claim 70, Chislenko-Chang teaches the method of claim 69 wherein comparing each of the plurality of user profiles with the target profile of the first user associated with the media player device to select the matching user profile comprises, at each peer media player device from the plurality of peer media player devices, comparing a one of the plurality of user profiles associated with a user of the peer media player device and the target user (i.e., Chang, page 3 paragraph [0026]).

Regarding claims 75 and 85, Chislenko teaches the method of claim 71 further comprising editing the playlist at the media player device to further include items played in excess of a threshold rate at the media player device (col. 10 lines 3-6).

Regarding claims 77, 87, and 92, Chislenko teaches the method of claim 61 wherein the media player device is a dedicated media player device (i.e., “an audio device”, col. 21 lines 45-49).

6. Claim 72, 82, and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chislenko, in view of Chang and Elliott, US 2005/0165888 A1.

Regarding claims 72, 82, and 91, Chislenko teaches the method of claim 71.

The combination of teachings of Chislenko and Chang does not explicitly teach automatically updating the playlist at the media player device in response to a change made to the playlist by the matching user.

Elliott teaches a technique for data replication and propagation allows synchronization of user interfaces on peer machines in a peer-to-peer network (abstract). Elliott teaches automatically updating the playlist at the media player device in response to a change made to the playlist by the matching user (page 3 paragraph [0031]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Chislenko and Chang to automatically

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updating the playlist at the media player device in response to a change made to the playlist by the matching user as taught by Elliot. One would be motivated to do so to enable a change made to the playlist by one user to be quickly reflected in the user interface of another user.

7. Claims 73 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chislenko, in view of Chang and Mercer et al. ("Mercer"), US 2004/0078382 A1.

Regarding claims 73 and 83, Chislenko teaches the method of claim 71.

The combination of teachings of Chislenko and does not explicitly teach filtering the playlist to remove at least one item that is not compatible with the media player device.

Mercer, in the same digital media content field of endeavor, teaches filtering the playlist to remove at least one item that is not compatible with the media player device (page 3 paragraph [036]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Chislenko and Chang to filter the playlist to remove at least one item that is not compatible with the media player device as taught by Mercer. One would be motivated to so to enable the selected media files to be filtered as a function of a media type associated with the media player.

8. Claims 74 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chislenko, in view of Shirwadkar et al. ("Shirwadkar"), US 2004/0162830 A1.

Regarding claims 74 and 84, Chislenko teaches the method of claim 71.

The combination of teachings of Chislenko and Chang does not explicitly teach filtering the playlist to remove at least one item that is not compatible with a location of the media player device.

Shirwadkar teaches filtering the playlist to remove at least one item that is not compatible with a location of the media player device (page 4 paragraph [0050]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Chislenko and Chang to filter the playlist to remove at least one item that is not compatible with a location of the media player device as taught by Shirwadkar. One would be motivated to do so to provide user with recommendations that are best matching with user profile in a current location of the device.

9. Claims 76 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chislenko, in view of Chang and Sakuma et al. ("Sakuma"), US 2006/0256669.

Regarding claims 76 and 86, Chislenko teaches the method of claim 71.

The combination of teachings of Chislenko and Chang does not explicitly teach editing the playlist at the media player device to remove items played less than a threshold rate at the media player device.

Sakuma teaches editing the playlist at the media player device to remove items played less than a threshold rate at the media player device (paragraph [0057]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Chislenko and Chang to edit the playlist at the media player device to remove items played less than a threshold rate at the media player device as taught by Sakuma. One would be motivated to do so to enable items that do not presumably match the user's preferences to be deleted from the device.

### ***Response to Arguments***

10. Applicant's arguments filed 05/04/2009 have been fully considered but they are not persuasive.

In the remarks, applicant argued in substance that

(A) Prior art does not teach selecting a playlist of matching user, and delivery the playlist to the media player device.

As to point (A), Chislenko teaches selecting a playlist (i.e., selecting the number of items/playlist that are highly rated by the user's neighbors, col. 10 lines 3-6), and delivery the playlist to the media player device (i.e., "to recommend items to a user, col. 10 lines 7-21 and col. 19 lines 41-42). Chang teaches a playlist of matching user (i.e., if it is a good match, the local apparatus send it own profile/playlist to the remote party, page 2 paragraphs [0021] and [0024]). Therefore, the combination of teachings of

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Chislenko and Chang does teach selecting a playlist of matching user and delivery the playlist to the media player device.

(B) Chang teaches away from selecting and delivering playlist to the media device associated with the target user.

As to point (B), examiner respectfully submits that the feature “selecting and delivering playlist to the media device associated with the target user” is disclosed by Chislenko.

It is noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

**11. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OANH DUONG whose telephone number is (571)272-3983. The examiner can normally be reached on Monday- Friday, 9:30PM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Oanh Duong/  
Primary Examiner, Art Unit 2455

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